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EXAMINER

GRAVINI, STEPHEN MICHAEL

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 10/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No. <b>09/627,870</b>	Applicant(s) <b>David H. SPROGIS</b>
Examiner <b>Stephen M. Gravini</b>	Art Unit <b>3622</b>



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1)  Responsive to communication(s) filed on 7-12-02

2a)  This action is FINAL. 2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

4)  Claim(s) 1-26 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-26 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner. If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some\* c)  None of:

1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                 | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). <u>2</u> | 6) <input type="checkbox"/> Other: _____                                    |

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## **DETAILED ACTION**

### ***Priority***

1. The following is law from 35 U.S.C. 119(e)(1):

An application for patent filed under section 111(a) or section 363 of this title for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in a provisional application filed under section 111(b) of this title, by an inventor or inventors named in the provisional application, shall have the same effect, as to such invention, as though filed on the date of the provisional application filed under section 111(b) of this title, if the application for patent filed under section 111(a) or section 363 of this title is filed not later than 12 months after the date on which the provisional application was filed and if it contains or is amended to contain a specific reference to the provisional application. No application shall be entitled to the benefit of an earlier filed provisional application under this subsection unless an amendment containing the specific reference to the earlier filed provisional application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this subsection. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed submission of an amendment under this subsection during the pendency of the application

2. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged.

However, the provisional application upon which priority is claimed is not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention (discussed infra). Domestic priority can not be granted under statute 119(e) because the provisional application is not described to one skilled in the art of cinema advertising to reasonably convey the information, at the time of filing, that the inventor had possession of the claimed invention in the manner provided by the first paragraph of section 112 of title 35 as filed under section 111(a) or section 363.

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***Requirements for Information***

3. The following is a rule from 37 CFR 1.105:

- (a) (1) In the course of examining or treating a matter in a pending or abandoned application filed under 35 U.S.C. 111 or 371 (including a reissue application), in a patent, or in a reexamination proceeding, the examiner or other Office employee may require the submission, from individuals identified under §1.56(c), or any assignee, of such information as may be reasonably necessary to properly examine or treat the matter, for example:
- (I) Commercial databases : The existence of any particularly relevant commercial database known to any of the inventors that could be searched for a particular aspect of the invention.
  - (ii) Search : Whether a search of the prior art was made, and if so, what was searched.
  - (iii) Related information : A copy of any non-patent literature, published application, or patent (U.S. or foreign), by any of the inventors, that relates to the claimed invention.
  - (iv) Information used to draft application : A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used to draft the application.
  - (v) Information used in invention process : A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used in the invention process, such as by designing around or providing a solution to accomplish an invention result.
  - (vi) Improvements : Where the claimed invention is an improvement, identification of what is being improved.
  - (vii) In Use : Identification of any use of the claimed invention known to any of the inventors at the time the application was filed notwithstanding the date of the use.
- (2) Where an assignee has asserted its right to prosecute pursuant to § 3.71(a) of this chapter, matters such as paragraphs (a)(1)(I), (iii), and (vi) of this section may also be applied to such assignee.
- (3) Any reply that states that the information required to be submitted is unknown and /or is not readily available to the party or parties from which it was requested will be accepted as a complete reply.
- (b) The requirement for information of paragraph (a)(1) of this section may be included in an Office action, or sent separately.
- (c) A reply, or a failure to reply, to a requirement for information under this section will be governed by §§ 1.135 and 1.136.

4. Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

In response to this requirement, please provide the title, citation and copy of each publication that any of the applicants relied upon to draft the claimed subject matter. For each publication, please provide a concise explanation of the

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reliance placed on that publication in distinguishing the claimed subject matter from the prior art.

In response to this requirement, please state the specific improvements of the subject matter in claims 1-26 over the disclosed prior art and indicate the specific elements in the claimed subject matter that provide those improvements. For those claims expressed as means or steps plus function, please provide the specific page and line numbers within the disclosure which describe the claimed structure and acts.

Examiner is particularly interested in Rule 105 criteria (a)(1)(v)-(vii), since it appears the present invention is an improvement on the old and well known art of cinema advertising. It appears that applicant's rigid comparison of at least one of the claims alleging unquestionable infringement has not provided sufficient priority such that the Digital Theatre Distribution System (DTDS) was published and in public use before the filing of the application thereof. For a quality examination, the Office is requiring:

information used to draft the application;

information used in the invention process, such as by designing around or providing a solution to published features of CineCast movie theater projector advertising to accomplish the claimed invention; and

identification of what is being improved by the claimed invention.

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In responding to those requirements that require copies of documents, where the document is a bound text or a single article over 50 pages, the requirement may be met by providing copies of those pages that provide the particular subject matter indicated in the requirement, or where such subject matter is not indicated, the subject matter found in applicant's disclosure.

The fee and certification requirements of 37 CFR 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 CFR 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 CFR 1.105 are subject to the fee and certification requirements of 37 CFR 1.97.

The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where the applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained will be accepted as a complete reply to the requirement for that item.

This requirement is an attachment of the enclosed Office action. A complete reply to the enclosed Office action must include a complete reply to this requirement. The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action.

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***Specification***

5. The disclosure is objected to because it contains several embedded hyperlinks and/or other forms of browser-executable code. Applicant is required to delete the embedded hyperlinks and/or other forms of browser-executable code. See MPEP § 608.01. Appropriate correction is required.

***Claim Objections***

6. Claim 4 is objected to because of the following informality: that claim does not contain a period such that it is a single complete sentence. Appropriate correction is required.

***Claim Rejections - 35 USC § 101***

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 15-16 and 25-26 are rejected under 35 U.S.C. 101 because the claimed method and system of does not recite a useful, concrete and tangible result under *In re Alappat*, 31 USPQ2d 1545 (Fed. Cir. 1994) and *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 47 USPQ2d 1596 (Fed Cir. 1998). The independently claimed initializing or providing, receiving or identifying, generating, and selecting contain recitations of descriptive material (i.e.

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for storing information or selecting data) that does not exhibit any functional interrelationship with the way in which initializing or providing, receiving or identifying, generating, and selecting are performed; such that the independently claimed invention does not constitute a statutory process, machine, manufacture or composition of matter under 35 USC 101. These independently claimed features are analogous to a book containing instructions or a compact disc containing music which do not recite a useful, concrete and tangible result and are not patentable under 35 USC 101. Because the independently claimed invention is directed to non-functional descriptive material which does not produce a useful, concrete and tangible result, those claims and claims depending from them, are not permitted under 35 USC 101 as being related to non-statutory subject matter. However in order to consider those claims in light of the prior art, examiner will assume that those claims recite statutorily permitted subject matter.

***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 1-26 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. Those claims recite the steps:

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“a movie identification input unit for receiving information regarding a movie that is to be shown in a theatre environment associated with a first of said plurality of digital projector assemblies and a controller for selecting data responsive to input;”

“movie identification input unit for receiving first theatre scheduling information regarding a movie that is to be shown in a first theatre, said movie identification input unit being coupled to a processing unit coupled to a computer storage unit, and said processing unit being adapted to provide a first portion to provide a first portion of the data representative of advertisement information to the first digital projector assembly responsive to said first theater scheduling information;”

“generating movie identification information regarding a movie that is to be shown in a theatre environment associated with a first of the plurality of digital projector assemblies;”

“common interest identification means for identifying a characteristic that each of the members of a first audience has in common, and for producing common interest information;” or

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“generating common interest data representative of said common interest characteristic”

are not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. Examiner does not find basis in the specification to convey the recited features such that the inventor had possession of the claimed invention at the time of filing. Specifically, the features of movie identification, theatre environment, first theatre scheduling information, common interest identification of an audience, or common interest characteristic are not recited in the specification and such that it would be reasonable to convey to those skilled in the art that the inventor had possession of the claimed invention (i.e. the specifically recited features). Since the independent claims are rejected under 35 USC 112, first paragraph, so are the depending claims. However, in order to consider these claims in light of the prior art, examiner will assume that these features were in possession of the inventor at the time of filing.

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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12. Claims 1-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Those claims recite the steps:

“a movie identification input unit for receiving information regarding a movie that is to be shown in a theatre environment associated with a first of said plurality of digital projector assemblies and a controller for selecting data responsive to input;”

“movie identification input unit for receiving first theatre scheduling information regarding a movie that is to be shown in a first theatre, said movie identification input unit being coupled to a processing unit coupled to a computer storage unit, and said processing unit being adapted to provide a first portion to provide a first portion of the data representative of advertisement information to the first digital projector assembly responsive to said first theater scheduling information;”

“generating movie identification information regarding a movie that is to be shown in a theatre environment associated with a first of the plurality of digital projector assemblies;”

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“common interest identification means for identifying a characteristic that each of the members of a first audience has in common, and for producing common interest information;” or

“generating common interest data representative of said common interest characteristic”

which fail to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Examiner does not find antecedent basis in the specification of the features of movie identification, theatre environment, first theatre scheduling information, common interest identification of an audience, or common interest characteristic and are therefore indefinite under this section of the statute. Since the independent claims are rejected under 35 USC 112, second paragraph, so are the depending claims. Claim 14 is further rejected under 35 USC 112, second paragraph, as failing to provide antecedent basis for the recited “said second theatre scheduling information.” However, in order to consider these claims in light of the prior art, examiner will assume that these features are not indefinite by having an antecedent basis from the specification.

13. The following is a quotation of the sixth paragraph of 35 U.S.C. 112:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

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14. Claims 17-23 are rejected under 35 U.S.C. 112, sixth paragraph, as not setting a limit on how broadly the Office may construe means-plus-function language under the rubric of reasonable interpretation (please see MPEP 2181). The independently claimed storage means, common interest identification means, selection means, and display means are not construed means-plus-function language under the rubric of reasonable interpretation, because the specification does not provide a clear limit of patentability. These four separate independently claimed means are merely exemplified after the “for” recitation and may incorporate any function that could be taught in the prior art, such as the features of a shopping mall kiosk, local bank, gasoline pump that accepts credit cards and other systems incorporating storage, common interest identification, selection, and display. In order to consider that claim in light of the prior art, examiner will assume that those claims contain a clear limitation under the broadest reasonable interpretation.

***Claim Rejections - 35 USC § 102***

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who

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has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

16. Claims 1-26 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Hughes et al. (WO 00/00917), non-patent literature reference “Partnership formed” from Screen Digest, or the NCN trademark filing of DTDS on December 30, 1999 and are rejected under 35 U.S.C. 102(b) as being clearly anticipated by von Kohorn (US 5,227,874), non-patent literature references “Movies get a chunk” from the Miami Herald, or “Proxima and NCN” from Business Wire, Greenwood et al. (US 5,568,181), Nemirofsky et al. (US 5,761,601), Ruybal et al. (US 5,801,754), DiFranza et al. (WO 99/36341), or Stern (WO 99/08216), and are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Cho al. (US 5,983,069), Decker et al. (US 6,009,465), Abecassis (US 6,038,367), Rider et al. (US 6,257,982), or non patent literature reference background information from NCNIInc.com.

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17. Claims 1-26 are rejected under 35 U.S.C. 102(b) based upon a public use or sale of the invention. The CineCast HD information posted on one of the assignee web sites states that as early as 1998 (based on the copyright notice in the product description) the claimed invention, as described in the specification, was available for public use or sale. The product lists some of its applications as e-cinema, high-end point of information, large format display, and advertising and video distribution. Each of these product applications perform the claimed invention as recited. Since the present application was filed in 2000, which is more than one year permitted for public use or sale under 35 USC 102(b), it is statutorily barred from being patented.

***Claim Rejections - 35 USC § 103***

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

20. Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over an obvious variation of the Cyberstar press release dated November 9, 1998 in view of Ballantyne et al. (US 5,133,079) or in view of Hunter (US 6,424,998). The press release discloses a method and system of movie projector theatre advertising comprising:

a computer storage unit or storage means to receive/store advertisement information which can be initialized (content can be send direction to a Windows NT based server);  
a plurality of digital projectors or digital projector assemblies receiving information or data from a computer storage unit (see the Shawn Whitcomb statement which implicitly uses digital projector assemblies since that company delivers in-theater media and in-theater media is delivered by digital projector assemblies recognized by the DTDS trademark filed as early as 1999); and

a controller or processing unit for selecting data for transmission in response to signals from an interrelated component (disclosed as Loral Skynet-operated satellites for video and data delivery when used in conjunction with the Windows NT based server). The press release also implicitly discloses the claimed projector computer communications including networking, assigned movie time and location including response, representative advertisement information composite framing, and attendance feedback including first showing information or exposure log reporting. These features are implicit because to those skilled in the art of marketing and

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advertising, each is a necessary component to marketing and advertising. The press release discloses the invention, recited by the applicants, except for the claimed movie identification input unit and the claimed common interest identification means. Ballantyne teaches that it is known to provide a movie identification unit (column 4 lines 20-26) and a common interest identification means (column 6 lines 24-55 in which membership implies common interest identification). Hunter teaches that it is known to provide a movie identification unit (column 10 line 6) and a common interest identification means (column 5 line 5 in which demographic analysis implies common interest identification). It would have been obvious to one skilled in the art of cinema advertising to combine the teachings of the Cyberstar press release with the teachings of Ballantyne or Hunter to provide the claimed movie identification input unit and the claimed common interest identification means for the purpose of allowing inexpensive and reliable cinema advertising. Furthermore, the claimed movie identification input unit and the claimed common interest identification means are merely non-functional descriptive material and do not patentably distinguish the claimed invention from the prior art. Both the claimed movie identification input unit and the claimed common interest identification means are merely data that is not manipulated to change a structure or process. Thus this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore it would have been further obvious to a person of ordinary skill in the art at the time the invention was made to claim any type of identification input or any type of identification means

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because such input or means does not functionally relate to the steps in the invention claimed and because the subjective interpretation of the nature does not patentably distinguish the invention.

***Conclusion***

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Non-patent literature article "Coming soon" by Paul Gough teaches advertising to movie theatre audiences.

22. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Steve Gravini whose telephone number is (703) 308-7570 and electronic transmission / e-mail address is "steve.gravini@uspto.gov". Examiner can normally be contacted Monday through Friday from 6:00 a.m. to 3:30 p.m. **If applicant chooses to send information by e-mail, please be aware that confidentiality of the electronically transmitted message cannot be assured.** Please see MPEP 502.02. Information may be sent to the Office by facsimile transmission. The Official Fax Numbers for TC-3600 are:

After-final	(703) 872-9327
Official	(703) 872-9326
Non-Official/Draft	(703) 872-9325

*Steve Gravini*  
**STEPHEN GRAVINI**  
**PRIMARY EXAMINER**

smg  
September 27, 2002